



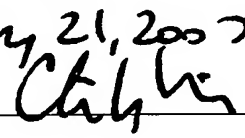
Art  
IFW

[10191/3549]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

-----X  
In re Application of: : Examiner: Samuel M. Heinrich  
: :  
Gert CALLIES et al. : :  
: :  
For: DEVICE FOR LASER DRILLING : :  
: : Art Unit: 1725  
: :  
Filed: March 10, 2004 : :  
: :  
Serial No.: 10/798,116 : :  
-----X

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:  
Date: May 21, 2007  
Signature: 

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

SIR:

This paper is filed in response to the “Examiner’s Answer” (“the Answer”) dated March 20, 2007 in connection with the above-captioned application.

REMARKS

Claims 9, 11 and 13 to 16 have been finally rejected and are now pending. For the reasons set forth in the Appeal Brief submitted on November 13, 2006 (“the Appeal Brief”) and those set forth below, it is again respectfully submitted that the final rejection of claims 9, 11 and 13 to 16 should be reversed.

Claims 9, 11, and 14 to 16 are rejected under 35 U.S.C. §102(b) as anticipated by Japanese Patent No. JP708155670A (“JP ‘670”). Claims 9, 11, and 14 to 16 are rejected under 35 U.S.C. §102(b) as anticipated by Japanese Patent No. JP 06000684A (“JP ‘684”). Claim 13 is rejected under 35 U.S.C. §103(a) as unpatentable over the combination of JP ‘670 and Japanese Patent No. JP7266073A (“JP ‘073”).

Appellant incorporates herein arguments previously presented in the Appeal Brief. In addition, the following comments are presented to further highlight the differences between the claimed subject matter and the applied references.

As set forth in the Appeal Brief, independent claim 9 recites, *inter alia*, that an electric field is applied between a workpiece and an electrode.

The Answer contends at page 3 that JP '670 describes a device that "can be arranged with an electric field such that the workpiece is either charged positive or negative." In JP '670 it is explicitly described that the voltage source supplies the electrodes with voltage for the generation of an electric field. See paragraph [0010] ("a power source device that supplies power to the electrodes for electrical field generation"). The workpiece is situated on one of the two electrodes. See paragraph [0018] ("and the workpiece [W] is mounted on the base electrode [2]"). Accordingly, the device described in JP '670 does not include the feature of an electric field that is applied between a workpiece and an electrode, as recited in independent claim 9. Instead, in JP '670 the workpiece is embedded in an electric field that is applied between two electrodes. Indeed, JP '670 acknowledges that that workpiece W may be nonconductive. See, e.g., paragraphs [0024] and [0029]. Thus, JP

The Answer also contends at page 3 that JP '684 describes a device that "has an electric field which prevents adhesion of scattered particles during laser surface treatment." In JP '684 a workpiece is fitted into an electric field. See paragraph [0008] ("when PGA1 is inserted into an electric field" (emphasis added)). As with JP '670, the electric field surrounding the workpiece is applied between the two electrodes 6, 7. See Figure 2. As such, JP '684 also fails to disclose an electric field that is applied between a workpiece and an electrode, as recited in independent claim 9.

Advantages of applying an electric field between a workpiece and an electrode are set forth in the Appeal Brief.

As for claims 11 and 14 to 16, which depend from claim 9 and therefore include all the limitations of claim 9, it is respectfully submitted that neither JP '670 nor JP '684 anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 9.

Regarding claim 13, as set forth above, Appellant incorporates herein arguments previously presented in the Appeal Brief. With respect to the Answer's characterization at page 5 of the arguments contained in the Appeal Brief as arguments against the references individually, Appellant respectfully submits that the Appeal Brief does

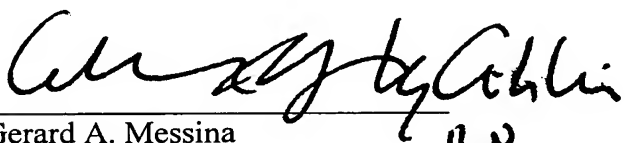
not argue against the cited references individually. Rather, the appeal Brief plainly argues against the proposed combination of references.

In view of the foregoing, reversal of all of the rejections set forth in the Final Office Action is therefore respectfully requested.

No fee is believed to be required in connection with this paper. However, if any fee is required in connection with this paper or this application, the Director is authorized to charge any and all such fees to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,

Dated: MAY 21, 2009

By:   
Gerard A. Messina  
Reg. No. 35,952  
RN  
42,194

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
CUSTOMER NO. 26646